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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,826	08/14/2000	Eike Duweing	50615	8623

7590

11/30/2001

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 11/30/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/636,826

Applicant(s)

DUWEING ET AL.

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 3-7, 9-11, 13-16, 17-41 and 43-54, drawn to a DNA construct with a plant V-ATPase promoter of *Beta vulgaris* V-ATPase subunit c isoform 2 [SEQ ID NO:1], a polynucleotide of SEQ ID NO:1, a recombinant vector, a microorganism, a transgenic plant and plant cell, methods of expressing a heterologous gene, and uses of the DNA construct and promoter, classified in class 435, subclass 419, for example.
  - II. Claims 1, 3-7, 9-10, 13-16, 17-41 and 43-54, drawn to a DNA construct with a plant V-ATPase promoter of *Beta vulgaris* V-ATPase subunit c isoform 1 [SEQ ID NO:2], a recombinant vector, a microorganism, a transgenic plant and plant cell, methods of expressing a heterologous gene, and uses of the DNA construct and promoter, classified in class 435, subclass 252.3, for example.
  - III. Claims 1, 3-7, 9-10, 13-16, 17-41 and 43-54, drawn to a DNA construct with a plant V-ATPase promoter of *Beta vulgaris* V-ATPase subunit A [SEQ ID NO:3], a recombinant vector, a microorganism, a transgenic plant and plant cell, methods of expressing a heterologous gene, and uses of the DNA construct and promoter, classified in class 435, subclass 468, for example.
  - IV. Claims 2 and 12, drawn to a DNA construct with a plant V-ATPase promoter that is deleted or hybrid, and to a polynucleotide encompassing the sequence of a deleted or

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hybrid *Beta vulgaris* V-ATPase subunit c isoform 2 promoter [SEQ ID NO:1],  
classified in class 536, subclass 24.1, for example.

V. Claim 8, drawn to a DNA construct with a plant V-ATPase promoter wherein at least one further pyrimidine stretch is inserted into the promoter, classified in class 435, subclass 320.1, for example.

VI. Claim 42, drawn to a recombinant protein, classified in class 530, subclass 350, for example.

2. The inventions are distinct, each from the other because of the following reasons:

3. The inventions of Groups I-VI are distinct products. The recombinant protein of Group VI is structurally and functionally distinct from the DNA constructs of Groups I-V, and can be used in different methods, such as a method of producing an antibody specific for the recombinant protein. The DNA constructs of Groups I-III are structurally and functionally distinct from each other because each contains a promoter from a different *Beta vulgaris* V-ATPase subunit gene, and each can be used separately. The DNA constructs of Groups IV-V are structurally and functionally distinct from the DNA constructs of Groups I-III because they contain a plant V-ATPase promoter that is altered relative to a native plant V-ATPase promoter, and each can be used separately. The DNA constructs of Groups IV-V are structurally and functionally distinct from each other because the DNA construct of Group IV contains a plant V-ATPase promoter that is deleted or hybrid, whereas the DNA construct of Group V contains a plant V-ATPase promoter wherein at least one further pyrimidine stretch is inserted into the promoter.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject

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matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and 1 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
November 21, 2001

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1800

